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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,589	04/09/2004	Yosuke Hosoya	09792909-5854	1893
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EXAMINER				
CANTELMO, GREGG				
ART UNIT		PAPER NUMBER		
1726				
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12/30/2010		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/821,589

Applicant(s)

HOSOYA ET AL.

Examiner

Gregg Cantelmo

Art Unit

1726

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,5 and 6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5 and 6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-940)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. In response to the amendment received December 16, 2010:
 - a. Claims 1, 3 and 5-6 are pending;
 - b. The prior art rejections of record stand.

Claim Rejections - 35 USC § 103

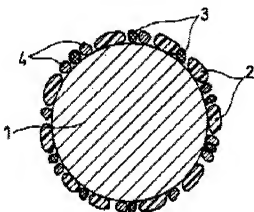
The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP '643 in view of either U.S. Patent No. 4,668,594 (Yamaura); U.S. Patent No. 5,958,281 (Takada) or U.S. Patent No. 6,475,663 (Mohwald).

JP '643 discloses a positive active material comprising: particles of a compound oxide of lithium and a transition metal 1 (figures and paragraphs 10 and 24) having an inherent layered structure thereby permitting the intercalation/deintercalation of lithium during charging/discharging and a coating layer on the active material 1 wherein the coating layer comprises an inorganic lithium compound 4 (paragraphs 10 and 23) and a carbonaceous conductive material 3 (paragraph 10 and 23 as applied to claim 1). The inorganic compound 4 is a lithium compound (paragraph 23 as applied to claim 1). The weight ratio of the particles 1 to the coating 2/3/4 teaches of particle weights of 10 grams relative to about 1 gram of coating material (see examples for weight ratios). Thus JP '643 teaches that the weight ratio of the particles will clearly be at least 70% but less than 98% relative to the coating layer 2/3/4 (as applied to claim 1). The positive

active material can be a variety of metal oxides including lithium nickel manganese oxide (para. 24 as applied to claim 1).

The coating layer with the inorganic filler 4 and carbonaceous material 3 substantially covers the entire surface of the base particle 1 as shown in Fig. 1).



JP '643 does not of the inorganic material being either lithium iron phosphate or lithium phosphate (claim 1).

As to the inorganic material being either lithium iron phosphate or lithium phosphate:

Essentially JP '643 teaches of coating lithium metal oxide base particles with a mixture of an inorganic conducting material and an electron conducting material.

While the inorganic conducting materials taught by JP '643 are not inclusive of either lithium iron phosphate or lithium phosphate, JP '643 does teach that the inorganic material is a lithium ion conductive inorganic solid electrolyte material (see abstract). Thus one of ordinary skill in the art would have reasonably appreciated that the inorganic material coated on the positive electrode active material could reasonably be

any known teach that the inorganic material is a lithium ion with a reasonable expectation that any such combination would effectively operate in the desired manner taught by JP '643, absent clear evidence to the contrary.

Each of lithium iron phosphate and lithium phosphate are art recognized ion conductive materials used in lithium secondary batteries as shown by either Yamaura (col. 5, ll. 33-37); Takada (col. 1, ll. 32-55); or Mohwald (col. 4, ll. 43-65). Thus it would have been apparent to one of ordinary skill in the art to use either lithium iron phosphate or lithium phosphate as an alternative ion conducting inorganic material coated onto the positive electrode since the primary reference teaches that it is generally known to coat lithium metal oxide base particles with a mixture of a lithium ion conducting inorganic material and an electron conducting material and since the specific inorganic materials of lithium iron phosphate and lithium phosphate are art recognized ion conductive materials used in lithium secondary batteries as shown by either Yamaura, Takada, or Mohwald.

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of JP '643 by selecting the lithium ion conducting inorganic material to be either lithium iron phosphate or lithium phosphate since such materials are art recognized lithium ion conducting inorganic materials as shown by either Yamaura, Takada, or Mohwald and one of ordinary skill in the art would have found such a modification to have provided the predictable result of providing a coating to the positive active material having both the requisite electron conducting and lithium ion conducting properties. The selection of a known material

based on its suitability for its intended use supported a prima facie obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945). See also *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). MPEP § 2144.07.

3. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP '643 in view of either Yamaura, Takada or Mohwald as applied to claim 1 above.

The difference between claim 3 and JP '643 is that JP '643 does not teach of the weight ratio between the inorganic material to the carbonaceous material being between 99:1 and 60:40.

While JP '643 discloses providing both an inorganic component 4 and carbon component 3 in a coating material to a positive active material 1, the disclosure does not specifically teach of the ratio of these two materials, however it is clear that there is an inherent ratio between these two components.

Varying the amount of each of components 2, 3 and 4 of the coating layer are recognizable optimizable components. One of ordinary skill in the art would have recognized that by varying the amount of carbon in the film, the electronic conductivity of film would vary accordingly. One of ordinary skill in the art would have also recognized that by varying the amount of the inorganic lithium compound in the film, the ionic conductivity of the film would vary accordingly. Adjusting the ratios of both materials will optimize the ionic and electronic conductivity of the film and selection of the claimed ratio would have been obvious to one of ordinary skill in the art since it

would have provided a coating which exhibited optimal ionic and electronic conductivities.

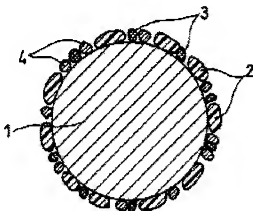
Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of JP '643 by adjusting the ratios of both the carbon component and inorganic component of the film of JP '643 within the ratio defined in claim 3 since the optimization of these would have been a recognized result-effective variable which could have been optimized since it would have provided a coating which exhibited optimal ionic and electronic conductivities. Generally, differences in ranges will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such ranges is critical. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). In re Hoeschele, 406 F.2d 1403, 160 USPQ 809 (CCPA 1969). It has been held that when the difference between a claimed invention and the prior art is the range or value of a particular variable, then a prima facie rejection is properly established when the difference in the range or value is minor. Titanium Metals Corp. of Am. v. Banner, 778 F.2d 775, 783, 227 USPQ 773, 779 (Fed. Cir. 1985).

4. Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP '643 in view of either U.S. Patent No. 4,668,594 (Yamaura); U.S. Patent No. 5,958,281 (Takada) or U.S. Patent No. 6,475,663 (Mohwald).

JP '643 discloses a positive active material comprising: particles of a compound oxide of lithium and a transition metal 1 (figures and paragraphs 10 and 24) having an

inherent layered structure thereby permitting the intercalation/deintercalation of lithium during charging/discharging and a coating layer on the active material 1 wherein the coating layer comprises an inorganic lithium compound 4 (paragraphs 10 and 23) and a carbonaceous conductive material 3 (paragraph 10 and 23 as applied to claim 5). The inorganic compound 4 is a lithium compound (paragraph 23 as applied to claim 5). The weight ratio of the particles 1 to the coating 2/3/4 teaches of particle weights of 10 grams relative to about 1 gram of coating material (see examples for weight ratios). Thus JP '643 teaches that the weight ratio of the particles will clearly be at least 70% but less than 98% relative to the coating layer 2/3/4 (as applied to claim 5).

The coating layer with the inorganic filler 4 and carbonaceous material 3 substantially covers the entire surface of the base particle 1 as shown in Fig. 1).



JP '643 discloses a nonaqueous secondary battery comprising: a negative active material and a positive active material comprising: particles of a compound oxide of lithium and a transition metal 1 (figures and paragraphs 10 and 24) having an inherent layered structure thereby permitting the intercalation/deintercalation of lithium during

charging/discharging and a coating layer on the active material 1 wherein the coating layer comprises an inorganic lithium compound 4 (paragraphs 10 and 23) and a carbonaceous conductive material 3 (paragraph 10 and 23 as applied to claim 5).

The positive active material can be a variety of metal oxides including lithium nickel manganese oxide (para. 24 as applied to claim 5).

JP '643 does not specify that the inorganic material is either lithium iron phosphate or lithium phosphate (claim 5) or the weight ratio between the inorganic material to the carbonaceous material being between 99:1 and 60:40 (claim 6).

Regarding the inorganic material being either lithium iron phosphate or lithium phosphate (claim and 5):

Essentially JP '643 teaches of coating lithium metal oxide base particles with a mixture of an inorganic conducting material and an electron conducting material.

While the inorganic conducting materials taught by JP '643 are not inclusive of either lithium iron phosphate or lithium phosphate, JP '643 does teach that the inorganic material is a lithium ion conductive inorganic solid electrolyte material (see abstract). Thus one of ordinary skill in the art would have reasonably appreciated that the inorganic material coated on the positive electrode active material could reasonably be any known teach that the inorganic material is a lithium ion with a reasonable expectation that any such combination would effectively operate in the desired manner taught by JP '643, absent clear evidence to the contrary.

Each of lithium iron phosphate and lithium phosphate are art recognized ion conductive materials used in lithium secondary batteries as shown by either Yamaura

(col. 5, ll. 33-37); Takada (col. 1, ll. 32-55); or Mohwald (col. 4, ll. 43-65). Thus it would have been apparent to one of ordinary skill in the art to use either lithium iron phosphate or lithium phosphate as an alternative ion conducting inorganic material coated onto the positive electrode since the primary reference teaches that it is generally known to coat lithium metal oxide base particles with a mixture of a lithium ion conducting inorganic material and an electron conducting material and since the specific inorganic materials of lithium iron phosphate and lithium phosphate are art recognized ion conductive materials used in lithium secondary batteries as shown by either Yamaura, Takada, or Mohwald.

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of JP '643 by selecting the lithium ion conducting inorganic material to be either lithium iron phosphate or lithium phosphate since such materials are art recognized lithium ion conducting inorganic materials as shown by either Yamaura, Takada, or Mohwald and one of ordinary skill in the art would have found such a modification to have provided the predictable result of providing a coating to the positive active material having both the requisite electron conducting and lithium ion conducting properties. The selection of a known material based on its suitability for its intended use supported a prima facie obviousness determination in *Sinclair & Carroll Co. v. Interchemical Corp.*, 325 U.S. 327, 65 USPQ 297 (1945). See also *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). MPEP § 2144.07.

Regarding the weight ratio between the inorganic material to the carbonaceous material being between 99:1 and 60:40 (claim 6):

While JP '643 discloses providing both an inorganic component 4 and carbon component 3 in a coating material to a positive active material 1, the disclosure does not specifically teach of the ratio of these two materials, however it is clear that there is an inherent ratio between these two components.

Varying the amount of each of components 2, 3 and 4 of the coating layer are recognizable optimizable components. One of ordinary skill in the art would have recognized that by varying the amount of carbon in the film, the electronic conductivity of film would vary accordingly. One of ordinary skill in the art would have also recognized that by varying the amount of the inorganic lithium compound in the film, the ionic conductivity of the film would vary accordingly. Adjusting the ratios of both materials will optimize the ionic and electronic conductivity of the film and selection of the claimed ratio would have been obvious to one of ordinary skill in the art since it would have provided a coating which exhibited optimal ionic and electronic conductivities.

Therefore it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to modify the teachings of JP '643 by adjusting the ratios of both the carbon component and inorganic component of the film of JP '643 within the ratio defined in claim 6 since the optimization of these would have been a recognized result-effective variable which could have been optimized since it would have provided a coating which exhibited optimal ionic and electronic conductivities.

Generally, differences in ranges will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such ranges is critical. In re Boesch, 617 F.2d 272, 205 USPQ 215 (CCPA 1980). In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). In re Hoeschele, 406 F.2d 1403, 160 USPQ 809 (CCPA 1969). It has been held that when the difference between a claimed invention and the prior art is the range or value of a particular variable, then a prima facie rejection is properly established when the difference in the range or value is minor. Titanium Metals Corp. of Am. v. Banner, 778 F.2d 775, 783, 227 USPQ 773, 779 (Fed. Cir. 1985).

Response to Arguments

5. Applicant's arguments filed December 16, 2010 have been fully considered but they are not persuasive.

Applicant currently argues that it is an indispensable condition to cover the front face of the particle ... with a lithium ion polymer and thus teaches of a three-part coating which must include the lithium ion polymer.

This argument is not persuasive since the claimed invention does not preclude a 3-part coating and does not preclude the presence of a lithium ion conducting polymer in the claimed invention.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., that the coating of the claimed invention does not include the presence of a lithium ion conducting polymer and is not a 3-part coating) are not recited in the rejected

claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The fact that the claims fail to recite the presence of materials other than the inorganic compound and carbonaceous material on the surface of the base particle does not limit the mixture only to those materials as the language of the claim fails to clearly limit the coating only to the inorganic compound and carbonaceous material. Again it is therefore evident that this argument is not persuasive since the claimed invention does not preclude a 3-part coating and does not preclude the presence of a lithium ion conducting polymer in the claimed invention.

The previous responses to arguments are maintained and incorporated herein as set forth in the previous office actions.

Therefore the particular claimed ratios are not held to be clearly patentable over the prior art of record and what would have been within the skill of the ordinary worker in the art and the prior art rejections of record stand.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregg Cantelmo whose telephone number is 571-272-1283. The examiner can normally be reached on Monday to Thursday, 8:30-6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pat Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Gregg Cantelmo/
Primary Examiner
Art Unit 1726